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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/581,551

04/12/2007

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EXAMINER

KIM, ALEXANDER D

ART UNIT

PAPER NUMBER

1656

NOTIFICATION DATE

DELIVERY MODE

03/15/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com
pto@gbpatent.com

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/581,551

Applicant(s)

MIYAWAKI ET AL.

Examiner

ALEXANDER KIM

Art Unit

1656

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 March 2011 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 4,7,10,11 and 18.

Claim(s) withdrawn from consideration: 1-3,5,6,8,9,12-17 and 19-36.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.

12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____.

/Alexander D Kim/
Primary Examiner, Art Unit 1656

Continuation of 5. Applicant's reply has overcome the following rejection(s): 35 USC§112, first paragraph, written description and scope of enablement; 35 USC 102(b) by Timms-Wilson et al., 102(b) or (a) by Karasawa et al..

Continuation of 11. does NOT place the application in condition for allowance because: The request for reconsideration in the reply filed on 03/01/2011 has been considered, however, the amendment does not place the application in condition for allowance. The amendment to the claims filed on 03/01/2011 has been entered. Thus, the previous claim objection mailed out on 10/20/2010 is withdrawn.

Applicants argue that obviousness-type double patenting rejections appear to be based in part on a claim interpretation, wherein the instant amendment clarifies that issue and accordingly, overcome the rejection; or hold the rejection in abeyance until all issues are resolved (see page 16, middle, Remarks filed on 3/1/2011). Applicants' argument has been fully considered; however, applicant's arguments are not found persuasive to overcome the outstanding obviousness-type double patenting rejections as set forth in the Office action mailed on 10/20/2010 for the reasons of record stated therein.

As shown in the previous non-final office action mailed out on 5/21/2010, the US Patent 7,541,451 teach a fluorescence protein with 11 mismatches (see sequence alignment result 2 on page 15, non-final office action mailed out on 5/21/2010), and fluorescence DNA with 34 mis-match (see the sequence alignment result 2 on page 16, non-final office action mailed out on 5/21/2010), meeting the limitation of claims 4 and 7; in turn meeting the limitations of claims 10, 11 and 18 for reasons stated in pages 12-16 of final office action mailed out on 10/20/2010; and in pages 8-9 of non-final office action mailed out on 5/21/2010; by the claims 1-8 of US Patent 7,541,451. Also, for the similar reasons stated on page 17, final office action mailed out on 10/20/2010, the claims 4, 7, 10, 11 and 18 have overlapping scope compared to the scope of claims 1-8 of US Patent 7,226,993, wherein any species within the overlapped scope encompassed by claims 1-8 US Patent 7,226,993 anticipate the instant claims 4, 7, 10, 11 and 18. As noted previously, the species of mutated gene encoding the fluorescent protein of SEQ ID NO: 3 (with 11 amino acid variation therefrom); and gene of SEQ ID NO: 7 (see alignment on page 18, non-final office action mailed out on 5/21/2010) encoding the fluorescent protein anticipated the instant genus gene encoding a fluorescent protein as in instant claims 4, 7, 10, 11 and 18. Furthermore, it is also noted that the instant claims also encompasses (i.e., do not exclude) any fluorescence protein having homo-multimer when it comes to describing the monomeric unit of said fluorescence protein. Appropriate terminal disclaimers and cancelling withdrawn claims would appear to make elected and examined claims 4, 7, 10-11 and 18 allowable.